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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,748	12/26/2000	Gerardo M. Castillo	25835-0014A	4503

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EXAMINER

FAY, ZOHREH A

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/748,748	Applicant(s) CASTILLO ET AL.	
	Examiner Zohreh Fay	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 17-30 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 17-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Claims 1-5 and 17-30 are presented for examination.

Claims 6-8 are cancelled.

Claims 9-16 are withdrawn from consideration as being directed to non-elected subject matter.

The finality of the office action of December 11, 2003 is hereby withdrawn.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 and 17-30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for certain disorders of amyloidosis, does not reasonably provide enablement for all disorders of amyloidosis. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112 first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir.1988).

The factors to be considered:

1) The nature of the invention:

The claims are drawn to the method of treating amyloidosis using the claimed compounds.

2) The state of the prior art:

According to the Lance Current Medical Diagnosis the treatment of different disorders associated with amyloidosis is different from each disorder to the next. For example the treatment of Alzheimer is considered to be different than the treatment of Mediterranean fever.

3) The relative skill of those in the art:

The relative skill of those in the art is high.

4) The predictability or unpredictability of the art:

The unpredictability of pharmaceutical and chemical arts is high.

5) The breadth of the claims:

The claims are very broad and encompass the treatment of all the disorders covered under the phrase amyloidosis.

6) The amount of direction or guidance presented:

Applicant's specification provides guidance and is only enabled for the treatment of certain diseases associated with amyloidosis. However, the specification provides no guidance, to enable one of ordinary skill in the art to use the invention commensurate in scope with the claims, which as stated above are broad and encompass treatment of all disorders associated with amyloidosis using the claimed compounds. In re Dreshfield, 110 F.2d 235, 45 USPQ 36 (CCPA 1940), gives this general rule: "It is well settled that in cases involving chemical and chemical compounds, which differ radically in their properties it must appear in applicant's specification either by the enumeration sufficient number of the members of a group or by other appropriate language that chemicals or chemical combinations included in the

claims are capable of accomplishing the desired results". In the instant case applicant's specification does not set forth a representative number of examples to demonstrate the treatment of disorders covered by amyloidosis using the claimed compounds.

Moreover, the specification does not provide, guidance to enable one of ordinary skill in the art to treat all disorders of amyloidosis.

7) The presence or absence of working examples:

The examples in the specification describe treating patients with certain amyloidosis disorders. Thus, the specification appears to enable one of ordinary skill in the art the use of the claimed compounds for the treatment of certain disorders of amyloidosis.

8) The quantity of experimentation necessary:

Since compound structure, and activity for such pharmaceutical use must be determined from case to case by painstaking experimental study, one of ordinary skill in the art would be burdened with undue experimentation to determine the effectiveness of all the claimed compounds for the treatment of all the disorders of amyloidosis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zohreh Fay whose telephone number is (571) 272-0573. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Z.F

Robert F.